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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/359,260	07/22/1999	ROBERT L. CAMPBELL	P3250	2590

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DAVID W. HIGHET, VP AND CHIEF IP COUNSEL  
BECTON, DICKINSON AND COMPANY  
1 BECTON DRIVE, MC 110  
FRANKLIN LAKES, NJ 07417-1880

EXAMINER

DEJONG, ERIC S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/359,260

Applicant(s)

CAMPBELL ET AL.

Examiner

Eric S. DeJong

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): see continuation sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 76, 82-95 and 128-134.  
Claim(s) withdrawn from consideration: 1-73 and 96-127.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

*John S. Brusca*  
JOHN S. BRUSCA, PH.D.  
PRIMARY EXAMINER

EDJ

*EDJ*

## Continuation of item #3. NOTE:

Applicants' proposed After Final amendment containing amendments to claims 76, 82-91, 131, 132, and 134, cancellation of claims 128-130, and the addition of new claims 135-138 introduce substantive changes that raise issues requiring further search and/or consideration, and therefore will not be entered. Proposed new claims 135, 136, and 138 recite the limitations "identifying a predetermined set of peptides", "parameterizing the predetermined set of peptides by: determining a first parameter for each predetermined peptide, wherein the first parameter is a whole molecule parameter, and determining a second parameter for each predetermined peptide, wherein the second parameter is dependent of the specific order of constitutive subunits within each predetermined peptide", "performing a space-filling design of the parameterized peptides", and "constructing a first peptide library comprising a plurality of a first test peptides identified using the space-filling design", and "measuring the indicia of each second test peptides". Proposed new claim 137 recites the limitations "parameterizing the initial peptides by: determining a first parameter for each initial peptide, wherein the first parameter is a whole molecule parameter, and determining a second parameter for each initial peptide, wherein the second parameter is dependent of the specific order of constitutive subunits of said initial peptide" and "performing a space-filling design of the parameterized peptides". These newly presented limitations would require further search and/or consideration. Applicants proposed amendments to claims 76 and 82-95 would alter the dependencies of said claims to depend from new claim 135, and therefore would include the new search and/or consideration requirements as cited above for new claim 135. Applicants proposed amendments to claims 131, 132, and 134 would alter the dependencies of said claims to depend from new claim 137, and therefore would include the new search and/or consideration requirements as cited above for new claim 137. Proposed amendments to claims 83, 84, and 86 that alter the previous wording of "said whole parameter" to "said first parameter" would alter the scope of indicated parameter and would require new search and/or consideration. Proposed amendments to claim 85 that alter the previous wording of "said sequence specific parameter" to "said second parameter" would alter the scope of the indicated parameter and would require new search and/or consideration.

## Continuation of Item #5. NOTE:

Review of the instant specification on pages 45 and 46 has revealed that the limitations of "selecting a subgroup of the first test peptides" and "expanding said first test peptides from said subgroup into their constituent compound isomers" do have proper and direct antecedent support. Therefore, the previous rejection of claim 129 on the grounds 35 USC § 112, first paragraph for failure to comply with the Written Description on the basis that the above cited limitations contain NEW MATTER is withdrawn.

## Continuation of Item #11. NOTE:

All remaining rejections in the previous Office Action, mailed 11 April 2005 are maintained for reasons of record.

Claims 76, 82-93, 95 and 128-134 are rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. This rejection is maintained for reasons of record.

If the after final amendment was entered, the cancellation of claims 128-130 and amendments to claims 72, 82-93, and 95 to depend from new claim 135 would be sufficient to overcome this rejection.

Claims 76, 82, 83, 87, 92-95, and 128-134 are rejected under 35 USC § 102(b) as being anticipated by Ostrem et al. This rejection is maintained for reasons of record.

If the after final amendment was entered, the cancellation of claims 128-130 and new claims 135-138 would require further search and consideration of new limitations as cited above. Applicants arguments have not been further consideration, since said arguments are directed toward claim amendments which have not been entered.